UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mail date: April 21, 2005

Cancellation No. 92043017

George Contos and Neil Pryor

v.

Cuzcatlan Beverages, Inc.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

The Board instituted this proceeding in an order dated March 8, 2004, with discovery set to close on September 9, 2004, and petitioners' testimony period to close December 23, 2004.[1]

Petitioners' uncontested motion, filed November 29, 2004 (accompanied by a certificate of mailing dated November 15, 2004) to extend their time until December 15, 2004 to respond to respondent's discovery requests is granted. *See* Fed. R. Civ. P. 6(b)(1); and Trademark Rules 2.127(a) and 2.197(a).

This case now comes up on the following motions:

1) petitioners' fully briefed second motion, filed December 21, 2004 (accompanied by a certificate of mailing dated December 15, 2004) to extend their time to respond to respondent's discovery requests;
2) respondent's fully briefed motion, filed December 28, 2004, for involuntary dismissal for petitioners' failure to take testimony; and
3) petitioners' fully briefed motion, filed January 3, 2005, to reopen the testimony periods.

[1] Respondent's timely filed answer to the petition to cancel is noted and entered.

Petitioners' second motion to extend time

In support of their first motion to extend their time to respond to respondent's discovery requests, petitioners indicated that Mr. Contos' father was admitted to the hospital in late October and passed away on November 10, 2004. Consequently, Mr. Contos was not able to assist in coordinating discovery.

In support of its second motion, petitioners indicate that they have been working diligently to respond to respondent's interrogatories and to gather documents, but need additional time to complete responses.

In response, respondent argues that petitioners have not shown good cause for the requested extension because they have not set forth with particularity facts in support of their motion; that petitioners' motion is untimely; and that petitioners' motion conflicts with the parties' agreement that no more extensions would be sought.

Contrary to respondent's position, and taken together, petitioners' two motions to extend time make a showing of good cause. Mr. Contos' father died just five days before the expiration of the time set under the first extension request. In view of the social norms surrounding arrangements for funerals and memorial services, initial estate consultations, and emotional toll, the circumstances presented by petitioners demonstrate good cause for the second extension request. Moreover, notwithstanding that their attention was necessarily

focused elsewhere, petitioners indicated that they were active in preparing responses to respondent's requests but needed more time. Respondent's position that the motion is untimely is unsupported. As to respondent's argument that the parties agreed that no more extensions would be had, the Board finds that the circumstances presented favor an additional extension, and notes further that the Board has the inherent authority to schedule disposition of the cases in its docket. *See* TBMP §510.01 (2nd ed. rev. 2004).

Accordingly, petitioners' motion for a second extension of time to respond to respondent's discovery requests is granted.

Respondent's motion for involuntary dismissal and petitioners' motion to reopen testimony

In support of its motion, respondent argues that petitioners' testimony period closed on December 23, 2004 and that petitioners did not take testimony or otherwise submit evidence in support of their petition to cancel.

In response, petitioners have filed a motion to reopen testimony, arguing that, because the parties have not yet exchanged discovery responses, there is not appreciable prejudice to respondent; that the length of delay is short, minimally impacting this proceeding; that an unexpected failure of counsel's docketing system resulted in the closing date not being reported on the monthly printout; and that petitioners have acted in good faith.

In response, respondent argues that petitioners were aware of the opening of their testimony period and did not seek an extension of time prior to the expiration of the period; that petitioners acted in bad faith by breaking an agreement not to seek further extension requests after the first request was consented to by respondent; and that, after the first extension request was consented to, petitioners relied upon contrary statements in support of their second extension request, sought on the grounds that the discovery requests were voluminous.

In reply, petitioners argue that they remained unaware of the closing date for their testimony period due to the electronic docketing error; that they remained engaged in this proceeding, including regular emails to respondent; and that the hospitalization and subsequent death of the father of one of the petitioner’s coincided with the time discovery responses were originally due and within the two week further extension consented to by respondent, amounting to a circumstance beyond petitioners’ control in coordinating discovery responses as agreed.

Trademark Rule 2.132(a) provides that when the party in the position of plaintiff fails to take testimony during the time allowed, judgment may be entered against it in the absence of a showing of good and sufficient cause. The "good and sufficient cause" standard, in the context of this rule, is equivalent to the "excusable neglect" standard, which would have to be met by any motion under Fed. R. Civ. P. 6(b) to reopen the plaintiff's

testimony period. *See Grobet File Co. of America Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989); *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982).

In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), the Supreme Court clarified the meaning and scope of "excusable neglect," as used in the Federal Rules of Civil Procedure and elsewhere. The Court held that the determination of whether a party's neglect is excusable is:

> at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include. . . [1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

Pioneer, 507 U.S. at 395. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most

important factor in a particular case. *See Pumpkin, supra* at footnote 7 and cases cited therein.

Turning to the *Pioneer* analysis, there does not appear to be any measurable prejudice to respondent should the Board reopen the proceeding. Respondent would bear no greater cost in defending this matter than it would have if petitioner had properly presented its case.

As to the second *Pioneer* factor, it is adjudged that the length of the delay and its potential impact on judicial proceedings are insignificant.

While it is respondent's position that petitioners have acted in bad faith, with respect to the fourth *Pioneer* factor, the Board finds that there is no evidence that petitioners' failure to take the appropriate steps at the assigned time period was the result of bad faith. Petitioners' have explained the unexpected hospitalization and death of Mr. Contos' father, which reasonably accounts for their inability to abide by any agreement not to seek further extensions of time. Moreover, the Board does not see that petitioners provided contrary statements in support of their need for extensions time. Finally, no bad faith exists

in the reliance by petitioners' attorney on an electronic docketing system that he has been using for years, even where he previously acknowledged the approach of the opening of the testimony period.

With respect to the third *Pioneer* factor, i.e. the reason for the delay and whether it was within petitioners' control, there is no doubt that petitioners were aware of the opening of their testimony period. However, reliance by petitioners' attorney on an electronic docketing system that he had been using for years was reasonable, and failure of that docketing system to call up the closing date appears to have been beyond petitioners' control. Petitioners' attorney has indicated steps undertaken to avoid such a failure in the future.

Accordingly, respondent's motion for involuntary dismissal is denied; and petitioners' motion to reopen and reset the testimony periods is granted.

Dates reset

The Board notes in passing, and the parties have not presented any indication to the contrary, that discovery closed on September 9, 2004. Thus, the service of respondent's

discovery requests on September 23, 2004 was untimely.[2] That is, discovery devices (discovery depositions, interrogatories, requests for production of documents and things, and requests for admissions) are available for use during the discovery period only, including the last day of discovery (although discovery depositions must be not only be noticed but also must be taken during the discovery period). A party has no obligation to respond to an untimely request. *See* TBMP §§403.01 and 403.02 (2nd ed. rev. 2004). Thus, it appears to be a benefit to respondent that petitioners continue to be willing to respond to respondent's discovery requests.

Accordingly, if the parties continue to so agree, they are allowed until **thirty days** from the mailing date of this order in which to respond to the outstanding discovery requests of their respective adversary.[3]

Discovery is closed and trial dates are reset as indicated below:

THE PERIOD FOR DISCOVERY TO CLOSE:	**CLOSED**
30-day testimony period for party in position of plaintiff to close:	August 15, 2005
30-day testimony period for party in position of defendant to close:	October 14, 2005
15-day rebuttal testimony period to close:	November 28, 2005

[2] The Board is unaware of the date upon which petitioners' discovery requests were served on respondent and, thus, makes no determination as to the timeliness of petitioners' requests.

[3] This is simply a scheduling order, not an order compelling discovery.

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Rule 2.l25.

Briefs shall be filed in accordance with Rule 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.l29.

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